



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,303	11/22/2000	Michelle Q. Wang Baldonado	001508-3160	8448

7590

02/09/2004

NIXON PEABODY LLP

Clinton Square

P.O. Box 31051

Rochester, NY 14603

EXAMINER

BAYARD, DJENANE M

ART UNIT

PAPER NUMBER

2141

3

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,303

Applicant(s)

WANG BALDONADO ET AL.

Examiner

Djenane M Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,480,885 to Olivier.

- a. As per claims 1,9,17 and 26, Olivier et al teaches an information stream monitoring system comprising: an information monitoring device that monitors one or more electronic documents in an information stream, and compares information about the one or more electronic documents to at least one rule (See col. 9, lines 50-54); and a forum spawning device that queries a set of users when at least one of the at least one rules is satisfied (See col. 5, lines 27-31), and creates a forum based on one or more replies from the set of users (See col. 9, lines 56-61 and col. 3, lines 29).

- b. As per claims 2, 10 and 18 Olivier et al teaches an invitation determining device that determines the set of users queried by the forum spawning device based on the one or more electronic documents (See col. 9, lines 2-41).

- c. As per claims 4, 12 and 20, Olivier et al teaches the claimed invention comprising a subscriber determining device that determines a set of subscribers based on the one or more electronic documents that satisfy at least one rule (See col. 9, lines 56-61).
- d. As per claims 5, 13 and 21, Olivier et al teaches a subscriber maintenance device that associates at least one user and the new forum (See col. 9, lines 50-54).
- e. As per claims 6, 14 and 22, Olivier et al teaches an electronic document storage device that stores the one or more electronic documents (See abstract, lines 3-9).
- f. As per claims 7, 15 and 23, Olivier et al teaches wherein the electronic document is at least one of- an electronic message; an e-mail-, a bulletin board posting; and an annotation to a shared document (See 8, lines 43-44).
- g. As per claims 8, 16 and 24, Olivier et al teaches wherein the information comparison is based on at least one of a rule-based model and a statistical-based model (See col. 11, lines 49-54).
- h. As per claim 25, Olivier et al teaches the information storage media wherein the information comparison compares at least one of subject information; electronic document posting information; and electronic document tracking information (See col. 9, lines 50-54).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,480,885 to Olivier in view of U.S. Patent No 6,651,086 to Manber et al.

a. As per claims 3, 11, and 19, Olivier et al teaches the claimed invention as described above. However, Olivier et al fails to teach wherein the forum spawning device queries the set of users to determine the need for the new forum.

Manber et al teaches a system and method for matching participants to a conversation. Furthermore, Manber et al teaches wherein the forum spawning device queries the set of users to determine the need for the new forum (See col. 2, lines 20-30).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the forum spawning device queries the set of users to determine the need for the new forum as taught by Manber et al in the claimed invention of Olivier et al in order to connect to or more individuals to a forum based on their mutual interests (See col. 1, lines 44-48).

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

  
**RUPAL DHARIA**  
**SUPERVISORY PATENT EXAMINER**